

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

SUN-P6114

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on 15 August 2006Signature Jeannie CamaraTyped or printed name Jeannie Camara

Application Number

09/843,495

Filed

25 April 2001

First Named Inventor

Ezhilan Narasimhan

Art Unit

2157

Examiner

Jacobs, Lashonda

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.
Registration number 47,615☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

Edward J. Grundler

Typed or printed name

(530) 759-1663

Telephone number

15 August 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on 15 August 2006
Jeannie Camara

(Typed or Printed Name of Person Mailing Paper or Fee)

Jeannie Camara
(Signature of Person Mailing Paper or Fee)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.	:	09/843,495	Confirmation Number: 9277
Filed	:	25 April 2001	
First Named Inventor	:	Ezhilan Narasimhan et al.	
Docket	:	SUN-P6114-MEG	
Title	:	Assessment Engine	
Group/Art Unit:		2157	
Examiner	:	Jacobs, Lashonda T.	

PRE-APPEAL BRIEF
IN SUPPORT OF APPELLANT'S APPEAL
TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

Commissioner for Patents
M/ S AF
P.O. Box 1450
Alexandria VA 22313-1450

Sir:

This pre-appeal brief is submitted in support of Applicant's Appeal from a Final Decision of the Examiner mailed **5 May 2006**. Applicant respectfully requests consideration of this pre-appeal brief by the pre-appeals panel.

I. SUMMARY OF CLAIMED SUBJECT MATTER

In one embodiment of the present invention, a computer **receives a rule** which defines a premise and a conclusion to be drawn if the premise is true. Next, the computer transmits the rule to a server. The server then stores the rule and **generates a function** (e.g., a PL/SQL function) that determines if the premise is true, and based at least in part upon the conclusion, outputs a first value if the premise is

true and outputs a second value if the premise is false. Next, the computer receives a parameter. The computer then transmits the parameter to the server, which uses the generated function to assess the parameter. Next, the server transmits the assessment back to the computer.

According to independent claim 1, a method of generating a function involves: (a) **receiving a rule** at a server from a client computer, wherein the rule defines a premise and a conclusion to be drawn if the premise is true; and (b) **generating a function** by the server that determines if the premise is true, and based at least in part upon the conclusion, outputs a first value if the premise is true and outputs a second value if the premise is false.

II. REMARKS AND ARGUMENTS

Claims 1-3, 5-8, and 10-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,598,036, issued to Wang, et al. (hereinafter “Wang”) in view of U.S. Patent No. 4,648,044, issued to Hardy, et al. (hereinafter “Hardy”). Claims 4 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wang in view of Hardy and further in view of U.S. Patent No. 6,651,054 issued to de Judicibus, et al. (hereinafter “de Judicibus”).

The final office action was mailed 5 May 2006. The Examiner’s grounds of rejections that Applicant appeals from are as follows. Applicant’s failure to specifically address a claim in this section should not be interpreted as agreement with the Examiner’s rejections of such a claim.

A. That Claim 1 is Unpatentable under 35 U.S.C. § 103 over Wang in view of Hardy

Claim 1 is an independent claim for a method of generating a function based on a rule. Claims 2-19 depend from claim 1.

The Examiner avers that Wang explicitly discloses **receiving a rule** from a client computer. The Examiner recognizes that Wang fails to explicitly disclose **generating a function** as recited in claim 1. The Examiner cites Hardy for this

subject matter. Applicant respectfully points out that the combination of Wang and Hardy cannot make the identified elements of claim 1 obvious, for the following reasons.

1. Wang Does Not Disclose Receiving a Rule

In claim 1 of the present application, a server **receives a rule** from a client computer, wherein the rule defines a premise and a conclusion to be drawn if the premise is true.

The Examiner avers that Wang discloses “receiving a rule.” In rejecting this element of claim 1, Examiner cites col. 3, lines 7-20 and 29-41 of Wang.

Applicant respectfully points out that the citation discloses receiving a proposed value. Note that a proposed value is a value that the user believes could be utilized in a design (see Wang, col. 3, lines 7-11). For example, a proposed value can be the overall length of a car (see Wang, col. 3, lines 14-20, FIG. 5, 33). However, the terms “value” and “rule” refer to fundamentally different entities. A value is a number (e.g., “100”) or a string (e.g., “red”). In contrast, a rule comprises a premise (e.g., “if automobile color = red”) and a conclusion (“then value = 100”). Hence, Applicant respectfully points out that Wang does not disclose “receiving a rule.”

2. Hardy Does Not Disclose Generating a Function

In claim 1, the server generates a function based on a rule. Specifically, a server first receives a rule from a client computer, wherein the rule defines a premise and a conclusion to be drawn if the premise is true. Next, the server **generates a function** that determines if the premise is true, and based at least in part upon the conclusion, outputs a first value if the premise is true and outputs a second value if the premise is false.

In rejecting this element of claim 1, the Examiner cites col. 7, lines 6-58, col. 10, lines 12-28 of Hardy. Applicant respectfully points out that the citation discloses “identifying a rule” and “applying a rule” (see Hardy, col. 7, lines 6-58). Specifically, the Examiner’s citation describes a Basic Expert System Tool (BEST) which receives a “goal” (see Hardy, col. 6, lines 67-68, col. 7, lines 1-3). Next,

BEST uses the goal to identify a rule in the knowledge base (see Hardy, col. 7, lines 8-14). BEST then applies the identified rule (see Hardy, col. 7, lines 15-58).

However, identifying and/or applying a rule is different from “generating” a function. The result of identifying a rule is a rule identifier, e.g., “Rule 2” (see Hardy, col. 6, lines 34-45, col. 7, lines 8-14). Similarly, the result of applying a rule is an output value, e.g., a string. For example, when Hardy’s invention applies “Rule 2,” it generates the output string “BEST has reached the following conclusions about wine: wine = burgundy (100%) because rule 2” (see Hardy, col. 7, lines 54-56). Hence, the result of identifying and/or applying a rule is either a rule identifier or an output value.

In contrast, the result of “generating a function” is a function which is a programming language construct that contains a set of instructions (e.g., a PL/SQL function). For example, the present invention can receive a rule and generate the following function in PL/SQL based on the rule (see page 7, lines 16-20):

```
function automobile_color (parameter_value
<DATATYPE>) return NUMBER as
begin
    if parameter_value like '%red%' then
        return 100;
    end;
```

It is evident that a “function” is fundamentally different from a “rule identifier” or an “output value.” Hence, Hardy does not disclose “generating a function.”

Indeed, the Examiner recognizes that “generating a function” is different from “applying a rule.” Examiner states that Wang fails to explicitly disclose “generating a function” (see office action, page 3, line 9). However, note that Wang discloses “applying a rule” to a proposed value to determine whether a proposed value is acceptable (see Wang, col. 3, lines 52-55). Hence, the Examiner must have recognized that “generating a function” is different from “applying a rule,” because otherwise, Examiner would not have cited Hardy.

Hence, by citing Hardy, the Examiner must be concluding that (a) “identifying a rule” is the same as “generating a function,” or (b) the combination of “identifying a rule” and “applying a rule” is the same as “generating a function.”

However, for reasons explained above, neither of those conclusions is supported by the facts. Hence, Hardy does not disclose "generating a function."

On page 3, line 19 of the office action, Examiner cites col. 11, lines 40-67 of Hardy as disclosing the claim element of "generating a function." Applicant respectfully points out that this citation discloses the operation of a subroutine called FINDCHAR which determines a location of a character within a string. Applicant fails to see how the description of the FINDCHAR subroutine is relevant to determining whether Hardy discloses the claim element of "generating a function."

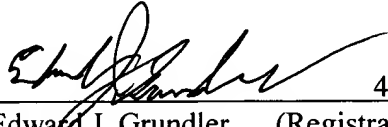
CONCLUSION

For the foregoing reasons, Appellant respectfully requests reversal of the Examiner's rejections as set forth in the Final Office Action and subsequent Advisory Action, and request that the pre-appeals panel direct allowance of all pending claims of the application.

Respectfully submitted,

Date: 15 August 2006

By:


Edward J. Grundler (Registration No.) 47,615

Park, Vaughan & Fleming LLP
Edward J. Grundler
PARK, VAUGHAN & FLEMING LLP
2820 Fifth Street
Davis, CA 95618-7759
Tel: (530) 759-1663
FAX: (530) 759-1665
Email: edward@parklegal.com